REMARKS

Claims 1, 4, 5, 7, 8, 12, 15, 16, 18, 19, 23, 26 and 27 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Lipner et al.* (U.S. Patent 5,557,346) in view of *Lohstroh et al.* (U.S. Patent 5,768,373). Claims 9, 10, 20 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Lipner et al.* and *Lohstroh et al.* as applied to claims 1 and 12 above, and further in view of *Dillaway et al.* (U.S. Patent 5,742,756). Claims 11, 22 and 29 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Lipner et al.* and *Lohstroh et al.* as applied to claims 1, 12 and 23 above, and further in view of *Kruys* (U.S. Patent 5,555,309). Applicants traverse these rejections on the grounds that these references are defective in establishing a *prima facie* case of obviousness.

Independent claims 1 and 12 include:

Claim 1. A method for encrypting data, the method comprising:

providing a first data processing system;

providing a second data processing system including program instructions to generate a session key, to decrypt original data using the session key, to encrypt the session key with a first user's public key, to encrypt the session key with a master public key, to generate a data packet including a plurality of encrypted session keys and encrypted data, and to transmit the data packet to the first data processing system;

generating and transmitting the data packet to another data processing system instead of or in addition to the first data processing system using the first user's public key, the session key, a new session key and the master public key; and

the first data processing system receiving the data packet and including program instructions to decrypt one of the encrypted session keys with a private

key of the first user, and to decrypt the encrypted data with the session key to re-create the original data.

Claim 12. A method for encrypting data comprising:

providing a first data processing system;

providing a second data processing system including program instructions to generate a session key, to decrypt original data using the session key, to encrypt the session key with a first user's public key, to encrypt the session key with a master public key, to generate a data packet including a plurality of encrypted session keys and encrypted data, and to transmit the data packet to the first data processing system;

generating and transmitting the data packet to another data processing system instead of or in addition to the first data processing system using the first user's public key, the session key, a new session key and the master public key;

the first data processing system receiving the data packet and including program instructions to decrypt one of the encrypted session keys with a private key of the first user, and to decrypt the encrypted data with the session key to re-create the original data; and

the master public key and a master private key allowing another user to gain access to encrypted data, the other user executing program instructions on the first data processing system to decrypt the one encrypted session key using the master private key, and to decrypt the encrypted data with the session key to re-create the original data.

As the PTO recognizes in MPEP §2142:

> ...The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the Examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of nonobviousness.....the Examiner must step backward in time and into

> the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made....The Examiner must put aside knowledge of the Applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'"

The cited references fail to disclose the claimed invention. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection because none of the cited references teach or even suggest the desirability of the combination claimed in the dependent claims and their respective independent claims. Moreover, none of the cited references provide any incentive or motivation supporting the desirability of the combination. These references do not achieve a combined teaching or suggestion of the method of claims 1 and 12.

The MPEP §2143.01 provides:

> The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Therefore, the Examiner's combination arises solely from hindsight based on the invention without any showing of suggestion, incentive or motivation in either reference for the combination.

Thus, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met.

The Federal Circuit has, on many occasions, held that there was no basis for combining references to support a 35 U.S.C. §103 rejection. For example, in *In re Geiger*, the court stated in holding that the PTO "failed to establish a *prima facie* case of obviousness":

> Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Monteffore Hospital*, 732 F.2d 15.72, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

The Federal Circuit has also repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. See *e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1798, 1792 (Fed. Cir. 1989).

More recently, the Federal Circuit found motivation absent in *In re Rouffet* , 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). In this case, the court concluded that the board had "reversibly erred in determining that one of [ordinary] skill in the art would have been motivated to combine these references in a manner that rendered the claimed invention [to have been] obvious." The court noted that to "prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness." The court further noted that there were three possible sources for such motivation, namely "(1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art." Here, according to the court, the board had relied simply upon "the high level of skill in the art to provide the necessary motivation," without explaining what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Notably, the court wrote: "If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance."

Therefore, independent claims 1 and 12 and the claims dependent therefrom are submitted to be allowable.

In view of the above, it is respectfully submitted that claims 1, 7-12 and 18-22 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

Respectfully submitted,

James R. Bell
Registration No. 26,528

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HAYNES AND BOONE, L.L.P.
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 512/867-8407
Facsimile: 214/200-0853
ipdocketing@haynesboone.com

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